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Docket No. 01-8007

REMARKS

This amendment is responsive to the final Office Action¹ mail-dated June 17, 2005.

Claims 1-7 and 9-49 were presented for examination and were rejected. Claims 1, 19, 20, 37, 42 and 48 are independent claims. Claims 37, 42 and 48 are amended. No new matter is added. No claims are added or canceled. Claims 1-7 and 9-49 are pending.

In the Office Action, the Examiner rejected claims 1-7, 9-11, 16-29 and 34-36 under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. (U.S. Patent No. 5,987,100) in view of Rodriguez et al. (U.S. Patent Publication No. 2002/0067806) further in view of Kobylevsky et al. (U.S. Patent No. 6,493,427); rejected claims 12, 13, 30, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Rodriguez et al. and further in view of McAllister et al. (U.S. Patent No. 6,442,242); rejected claims 14, 15, 32, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Rodriguez et al. and further in view of Tullis et al. (U.S. Patent No. 5,802,314); rejected claims 37-40, 48, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Tullis et al.; rejected claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Tullis et al. and further in view of Rodriguez et al.; and, rejected claims 42-47 under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Rodriguez et al..

Applicants respectfully traverse these rejections for the following reasons:

¹ The Office Action may contain a number of statements characterizing the cited reference(s) and/or the claims which Applicant(s) may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant(s) does not automatically subscribe to, or acquiesce in, any such statement. Further, silence with regard to rejection of a dependent claim, when such claim depends, directly or indirectly, from an independent claim which Applicant(s) deems allowable for reasons provided herein, is not acquiescence to such rejection of that dependent claim, but is recognition by Applicant(s) that such previously lodged rejection is moot based on remarks and/or amendments presented herein relative to that independent claim.

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McAllister Not Usable as Prior Art Under 35 U.S.C. § 103(c)

Claims 12, 13, 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Rodriguez et al. and further in view of McAllister et al. As Applicants have pointed out in several responses, McAllister et al. cannot be used as prior art against this application under 35 U.S.C. § 103. Effective November 29, 1999, subject matter that was prior art under 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person [35 U.S.C. § 103(c)]. The subject matter of the McAllister et al. patent and the claimed invention of the present application were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely Verizon. Therefore, the McAllister et al. patent cannot be used as prior art against this application under 35 U.S.C. § 103.

Applicants previously noted this deficiency in the Examiner's rejection(s) in the Amendment filed July 11, 2003, again in the Request for Reconsideration filed December 23, 2003, and yet again in the response filed on June 15, 2004. The Examiner has maintained this rejection without addressing Applicants' arguments. Because the McAllister et al. patent is not prior art against this application, any rejection based on the McAllister et al. patent must be withdrawn. See MPEP §§ 706.02(I)(1), 706.02(I)(2)(II). The rejection against claims 12, 13, 30 and 31 is thus overcome and the claims are thus allowable.

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Claims 1-7, 9-11, 16-29 and 34-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Rodriguez et al. further in view of newly-cited Kobylevsky et al. This combination of references does not disclose or suggest the subject matter of these claims for the following reasons. Consider, for example, claim 1:

A method for delivering a message to a receiving party, comprising: receiving a message intended for the receiving party; determining whether the message should be delivered to the receiving party; translating the message from a source format to message text; converting the message text to an audible message when the message should be delivered to the receiving party; determining a date or time at which the audible message should be delivered; initiating a telephony call to the receiving party at the determined date or time; and delivering the audible message to the receiving party during the telephony call. (Emphasis added.)

Clearly, claim 1 calls for delivering a message to a receiving party. In claim 1, the received message is translated and converted into an audible message, and it is the resulting audible message (directly related to and derived from the received message) which is delivered to the receiving party.

In the final Office Action, page 6, bottom, the Examiner admits that Fortman et al. in view of Rodriguez et al. does not teach “determining a date or time at which the audible message should be delivered” and Applicants agree. The Examiner then alleges that: “Kobylevsky teaches determining a date or time at which the reminder [i.e., audible message] should be delivered (col. 9; lines 11-30, col. 20, lines 1-4, 20-27)” (emphasis added) and Applicants respectfully disagree. Kobylevsky et al. relates to a remote prescription refill system for a pharmacy - the pharmacy is the receiving party and the customer is the calling party. In Col. 9, lines 11-30, and col. 20, lines 1-4 and 20-27 of Kobylevsky et al. the discussion is about the time of day when calls are placed but this discussion is irrelevant to Applicants’ claims. This

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discussion is irrelevant because the calls are being placed BY the pharmacy (receiving party) TO the customer (calling party) at a particular or pre-determined time of day. This does not disclose or suggest the claimed receiving party receiving, at a pre-determined time of day, a message from a sending party. The Examiner states that Kobylevsky et al. teaches determining a date or time when the “audible message” should be delivered, but this cannot possibly be true because Applicants’ recited “audible message” is derived from Applicants’ recited “message” and the recited message is delivered TO the receiving party, not from the receiving party. Since Kobylevsky et al. teaches the opposite - calls are placed by the receiving party - it cannot be relied upon to reject Applicants’ claim 1. Therefore, at least: “determining a date or time at which the audible message should be delivered” as recited in claim 1 is not disclosed by Fortman et al. or Rodriguez et al. as the Examiner admits and is also not disclosed or suggested by the reverse functioning in Kobylevsky et al. which actually teaches away from Applicants’ claim 1. This same argument applies to claims 2-7, 9-11 and 16-18, all of which depend from claim 1 and all of which are also rejected over Kobylevsky et al. It is therefore respectfully requested that the rejection of all of these claims be withdrawn and the claims allowed.

Claims 12-15, dependent from claim 1 are likewise allowable, at least by reason of their dependency from allowable base claim 1. In addition, claims 12-13 are allowable because they are rejected over Fortman et al., Rodriguez et al. and Mcallister et al., where it has been clearly explained above (and asserted multiple times in this record) that Mcallister et al. is disqualified as prior art against the claimed invention. (See page 16, above.)

Independent claim 19 recites: “A system for presenting a message to a receiving party comprising: means for obtaining a user profile corresponding to the receiving party, the user

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profile comprising delivery data that specifies a time or date of message delivery." (Emphasis added.) Again, this message delivery is to the receiving party wherefore Kobylevsky et al. is ineffective as a reference to teach or suggest this claim limitation, for reasons given above. It is therefore respectfully requested that this rejection of this claim be withdrawn and the claim allowed.

Independent claim 20 recites, *interalia*, "a message receiver configured to: initiate a telephony call to the receiving party at a time specified by the receiving party." (Emphasis added.) Claim 20 is not disclosed by Fortman et al. or Rodriguez et al. as the Examiner admits on pages 5 and 6 of the final Office Action, and is also not disclosed or suggested by the reverse functioning in Kobylevsky et al. for reasons given above and which actually teaches away from Applicants' claim 20, as explained above. This same argument applies to claims 21-29 and 34-36, all of which depend from claim 20 and all of which are also rejected over the combination of Fortman et al., Rodriguez et al., and Kobylevsky et al. It is therefore respectfully requested that the rejection of all of these claims be withdrawn and the claims allowed.

Claims 30-33, dependent from claim 20 are likewise allowable, at least by reason of their dependency from allowable base claim 20. In addition, claims 30-31 are allowable because they are rejected over Fortman et al., Rodriguez et al. and Mcallister et al., where it has been clearly explained above (and asserted multiple times in this record) that Mcallister et al. is disqualified as prior art against the claimed invention. (See page 16, above.)

Next, claims 37-40, 48, and 49 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Tullis et al.

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Claim 37 has been amended to include a limitation similar to that discussed above with respect to claims 1, 19 and 20. Claim 37 recites, *interalia*, “instructions for initiating a voice call to the receiving party at a pre-determined date and time identified by the receiving party.” (Emphasis added.) Support for this amendment can be found in the specification (*see*, at least, pgs. 9, ¶36; pg. 14, ¶54 and pg. 17, ¶64). The final Office Action, pg. 15-16, admits that Fortman et al. fails to teach at least four elements of claim 37 and alleges that Tullis et al. cures the deficiency in Fortman et al. in each instance. Applicant does not acquiesce in that rejection for reasons earlier presented in the record. However, in any event, Kobylevsky et al. and not Tullis et al. is cited to teach “determining a date or time at which the reminder [i.e., audible message] should be delivered” (final Office Action, pg. 6). In view of the argument presented above in connection with claim 1, Kobylevsky et al. is ineffective to disclose or suggest “instructions for initiating a voice call to the receiving party at a pre-determined date and time identified by the receiving party” as recited in claim 37. Thus, the combination of Kobylevsky et al. with the other references do not disclose or suggest claim 37. It is therefore respectfully submitted that the rejection of claim 37 be withdrawn and the claim allowed. Claims 38-41 depend from claim 37 and are also allowable, at least for reasons based on their respective dependencies from allowable base claim 37.

Claim 48 has been amended to include a limitation similar to that discussed above with respect to claim 37. Claim 48 recites, *interalia*, “initiating a telephony call to a telephony device associated with the receiving party at a pre-determined date and time.” (Emphasis added.) Support for this amendment can likewise be found in the specification (*see* pg. 9, ¶36; pg. 14, ¶54 and pg. 17, ¶64). For reasons given above with respect to claim 37, the rejection of claim 48

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should be withdrawn and the claim allowed. Claim 49 is dependent from claim 48 and is also allowable at least because of its dependency from allowable claim 48.

Lastly, claims 42-47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fortman et al. in view of Rodriguez et al. In the final Office Action, page 3, it is alleged that Fortman et al. "identifies at least one message criterion that indicates when messages should be delivered to the subscriber" (emphasis added) and cites col. 5, lines 10-15 and 42-49 as well as col. 7, lines 17-18 and 49-64. These sections of Fortman et al. do not disclose one message criterion that indicates when messages should be delivered to the subscriber and these sections have been previously refuted by Applicants on the record.

As previously explained, column 5, lines 10-15, of Fortman et al. corresponds to Table 1 in Fortman et al. In Table 1, Fortman et al. discloses different types of notifications that may be used to notify a subscriber of a pending message. Fortman et al. does not disclose or suggest at least one message criterion that indicates when messages should be delivered to the user, as required by claim 42.

At column 5, lines 42-49, Fortman et al. discloses:

Subscriber mailbox 3300 preferably also stores a database of subscriber profile data. The subscriber profile data includes subscriber-defined information regarding the subscriber's notification preferences. The subscriber profile data might include any of the notification types shown in Table 1, including notifying the subscriber using a message waiting light or tone, or by sending part or all of the message to the subscriber as the notification.

Nowhere in this section, or elsewhere, does Fortman et al. disclose or suggest at least one message criterion that indicates when messages should be delivered to the user, as required by claim 42.

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At column 7, lines 16-19, Fortman et al. discloses that the "subscriber notification may include a message waiting light or tone on the subscriber's telephone, or the message itself delivered to the subscriber's ADSI telephone, pager, fax, or computer (Table 1)." Nowhere in this section, or elsewhere, does Fortman et al. disclose or suggest at least one message criterion that indicates when messages should be delivered to the user, as required by claim 42.

At column 7, lines 49-64, Fortman et al. discloses:

For example, if the subscriber uses ADSI telephone 2130 to retrieve the pending message, the subscriber must specify whether the pending message should be downloaded in voice or ADSI text form.

Interface 3100 then routes the request to service provider 3200. Based on the detected type of subscriber telecommunications equipment and any subscriber specified retrieval format, service provider 3200 determines the subscriber's retrieval format [step 8300]. Service provider 3200 reads the pending message from subscriber mailbox 3300 and determines whether the message is already in the retrieval format [step 8400]. The message would already be in the retrieval format if the retrieval format is the same as the caller format or the subscriber's normal retrieval format. If the message is already in the retrieval format, then service provider 3200 sends the message to the subscriber [step 8500].

Nowhere in this section, or elsewhere, does Fortman et al. disclose or suggest at least one message criterion that indicates when messages should be delivered to the user, as required by claim 42.

The Examiner, to Applicants' puzzlement, was apparently not persuaded by this clearly persuasive argument. Therefore, to the extent that the Examiner may be interpreting (i.e., misinterpreting) these sections in such a manner that a subscriber allegedly is indicating when a message should be delivered, by the subscriber's very act of indicating a notification preference, (although these sections do not disclose or suggest that a message is delivered at the time of the preference indication), then the current amendment to claim 42 overcomes that interpretation.

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A subscriber notification preference in Fortman et al. necessarily occurs AFTER a signal has been sent to the receiving party alerting the receiving party of the existence of a message. By contrast, claim 42 recites, *interalia*, “prior to monitoring messages, interacting with a user to generate a user profile that identifies at least one message criterion that indicates when the messages should be delivered to the user.” (Emphasis added.) This amendment is supported in the application as filed, at least in the specification pages 13-16 and Figs. 6-7. Claim 42 has thus been amended to more specifically recite that the user profile is generated before monitoring for messages. It is therefore impossible for Applicants’ user in claim 42 to generate a user profile indicating preferences while, or after, receiving messages or any possible notice of those messages, because Applicants’ message monitoring hadn’t started yet. Applicants’ user profile is generated during the set up phase which clearly occurs before the monitoring phase. By contrast, Fortman et al cannot indicate a preference for message delivery until after existence of the message is communicated to the subscriber (user). Therefore, even if Fortman et al. can somehow be construed to suggest when messages should be delivered to the user, (a notion with which Applicants disagree) it certainly does not disclose or suggest such delivery prior to monitoring for those messages as Applicants-claim.

Accordingly, any rejection of claim 42 based on the notion that Fortman et al. discloses or suggests that the subscriber indicates when a message should be delivered should be withdrawn. Moreover, the Kobylevsky et al. reference does not cure this deficiency in Fortman et al. because it discloses the reverse operation - it discloses when a message should be delivered from a user (i.e., from the called party pharmacy making calls to the calling party customers to pick up their prescriptions). Clearly, this reverse functionality teaches away from Applicants’ claim 42

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wherefore Kobylevsky et al. in combination with the other applied references do not disclose or suggest claim 42. It is, therefore, respectfully submitted that the rejection of claim 42 be withdrawn and the claim allowed.

Claims 43-47 are dependent from claim 42 and are also allowable, at least for reasons based on their respective dependencies from allowable base claim 42.

In accordance with MPEP 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. And, all three of these basic criteria must be met - if any one is not met the prima facie case of obviousness is not made.

In this instance, the prior art references, when combined, do not teach or suggest all of the claim limitations of all of the claims. Accordingly a prima facie case of obviousness has not been established. The other two criteria are mooted by the failure of the references to meet this one criteria and shall not be further addressed at this time.


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CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the allowance of the pending claims. This amendment should be entered under 37 C.F.R. § 1.116 because the amendments to claims 37, 42 and 48 do not add new matter, do not require further searching or consideration and do narrow-down issues to be presented on appeal if the Examiner is still not persuaded to allow this application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2339 and please credit any excess fees to such deposit account.

Respectfully submitted,
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